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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,418	08/10/2000	Christopher E. Axe	021756-018700US	6284
51206	7590	07/17/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	<b>Application No.</b> 09/636,418	<b>Applicant(s)</b> AXE ET AL.	
	<b>Examiner</b> Gregory J. Vaughn	<b>Art Unit</b> 2178	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 16 November 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

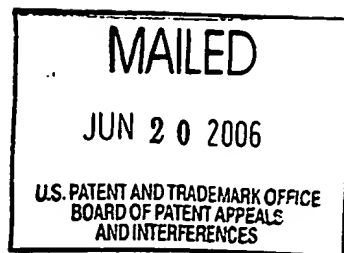
1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court of the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

Please find attached the "Order Returning Undocketed Appeal To Examiner" which describes the deficiencies noted by the Board of Patent Appeals and Interferences (BPAI). The BPAI has ordered the examiner to notify appellant to submit a substitute Appeal Brief which corrects the "Summary of claimed subject matter" and includes the "Evidence Appendix" and "Related Proceedings Appendix".

**STEPHEN HONG**  
SUPERVISORY PATENT EXAMINER

Attachment: Order Returning Undocketed  
Appeal, 5 pgs, 6/20/2006

UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHRISTOPHER E. AXE and MARCO S. CASALAINA

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Application 09/636,418

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on June 19, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on November 16, 2005.

37 CFR § 41.37(c)(1)(v) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by

a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

....

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an

amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

The “Summary of claimed subject matter” appearing on pages 2 and 3 of the Appeal Brief filed November 16, 2005 is deficient because it does not map the claimed invention to the independent claims. Correction is required.

An in-depth review of the Appeal Brief also indicates that the following sections are missing:

- 1) “Evidence appendix,” as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) “Related proceedings appendix,” as set forth in 37 CFR § 41.37(c)(1)(x).

A substitute brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled “More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule” located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

An Examiner’s Answer was mailed on February 10, 2006 in response to the Appeal Brief filed November 16, 2005.

Section § 1207.02 of the Manual of Patent Examining Procedure (MPEP) (8<sup>th</sup> Ed., Rev. 3, August 2005) states:

### Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

It is noted that while the Examiner's Answer states that "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal" [page 4 under the caption "Evidence Relied Upon"], the claim rejections in the Final Rejection<sup>1</sup> mailed January 27, 2005 are listed as follows:

1. Claims 1-3, 6-9, 14-17, 23-30, 32 and 33 remain rejected under 35 U.S.C. 102(b) as being anticipated by Henson US Patent 6,167,383, filed 9/22/1998, patented 12/26/2000 [page 4];
2. Claims [sic] 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Henson [page 4];
3. Claims 4, 5, 11-13 and 18-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Henson [page 14];
4. Claims 10, 21, 22 and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999, patented 12/12/2000 [page 16]; and

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<sup>1</sup> It is noted that in accordance with MPEP § 1207.02(A)(9):

(c) For each rejection under 35 U.S.C. 102, the examiner's answer must explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations in the rejected claims are found in the prior art relied upon in the rejection; and

(d) For each rejection under 35 U.S.C. 103, the examiner's answer must:

- (i) state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection,
- (ii) identify the differences between the rejected claims and the prior art relied on (i.e., the primary references), and
- (iii) explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.

5. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King.

Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) for notification to appellants to submit a substitute Appeal Brief which corrects the "Summary of claimed subject matter," and includes the "Evidence Appendix" and "Related Proceedings Appendix";

2) for submission of a revised Examiner's Answer which corrects the "Evidence Relied Upon" and the "Grounds of Rejection" sections; and

3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

DALE M. SHAW

Deputy Chief Appeal Administrator  
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DMS:psb

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